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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,729	07/02/2003	Kevin T. Chan	14227US01	5781
23446 7590 02/26/2007 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			EXAMINER DAVENPORT, MON CHERI S	
			ART UNIT	PAPER NUMBER
			2609	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/26/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/612,729

Applicant(s)

CHAN, KEVIN T.

Examiner

Mon Cheri S. Davenport

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in-condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/7/06 and 11/3/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

1. This Action is in response to the Application filed July 2, 2003.

Information Disclosure Statement

2. The references listed in the Information Disclosure Statement file on November 3, 2003 and August 7, 2006 have been considered by the examiner (see attached PTO-1449 form or PTO/SB/08A and 08B forms).

Specification

3. The disclosure is objected to because of the following informalities: Paragraph [01] needs to be updated with serial number, date, and status (publication number if published) of cited application.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 11-20** rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claims 11-20, the claimed machine-readable storage is nonstatutory subject matter since it's not a machine, manufacture, process, or composition of matter.

See MPEP 2160(IV)(B)(1).

Claims 11-20 lacks the proper preamble language for statutory computer program product. See MPEP 2100 for guidance on computer related inventions.

The examiner suggest a preamble as follows:

"A computer readable medium containing computer executable instructions to perform a method, the method comprising:" Correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. **Claims 1, 11 and 21** provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 11, and 21 of copending Application No. 10/612,025. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following.

5. Regarding **Claim 1** of instant application, claim 1 of application number 10/612,025 discloses a method, for providing and configuring communication links, the method comprising:

determining any one usable media pair from all existing media pairs;

selecting any one channel from all existing channels; and
assigning said selected any one channel to said any one media pair.

In addition , claim 1 of 10/612,025 is more specific than claim 1 of present application. Conflicting claims in the instant application are not patentably distinct because conflicting claims are broader and generic with respect to the applied reference claims, i.e., an obvious variation. Many decisions support the fact that a broad or generic claim is obvious from a specific claim, i.e., an obvious variation. See *In re Van Ornum and Stang*, 214 USPQ 761 (CCPA 1982); *In re Goodman* (CA FC) 29 USPQ2d 2010 (12/3/1993); *In re Vogel and Vogel*, 164 USPQ 619 (CCPA 1970); *In re Berg* (CA FC) 46 USPQ2d 1226 (3/30/1998); *Eli Lilly and Co. v. Barr Laboratories Inc.*, 58 USPQ2d 1865 (CA FC 2001). It is well settled that omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. This notion is supported by *In re KARLSON*, 136 USPQ 184 (1963); *In re Nelson*, 95 USPQ 82 (CCPA 1952); and *In re Eliot*, 25 USPQ 111 (CCPA 1935).

Regarding **Claim 11** of instant application, claim 11 of application number 10/612,025 discloses a machine-readable storage having stored thereon, a computer program having at least one code section for providing and configuring communication links, the at least one code section being executable by a machine for causing the machine to perform steps comprising: determining any one usable media pair from all existing media pairs; selecting any one channel from all existing channels; and assigning said selected any one channel to said any one media pair.

In addition , claim 11 of 10/612,025 is more specific than claim 11 of present application. Conflicting claims in the instant application are not patentably distinct because conflicting claims are broader and generic with respect to the applied reference claims, i.e., an obvious variation.(see above)

Regarding **Claim 21** of instant application, claim 21 of application number 10/612,025 discloses a system for providing and configuring communication links, the system comprising: at least one controller adapted to determine any one usable media pair from all existing media pairs; at least one selector adapted to select any one channel from all existing channels; and said at least one controller adapted to assign said selected any one channel to said any one media pair.

In addition , claim 21 of 10/612,025 is more specific than claim 21 of present application. Conflicting claims in the instant application are not patentably distinct because conflicting claims are broader and generic with respect to the applied reference claims, i.e., an obvious variation. (see above)

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. **Claims 1-30** rejected under 35 U.S.C. 102(b) as being anticipated by Bontemps et al. (US Patent Number 5,923,663).

It is noted that the language used by Applicant merely suggests or makes optional those features described as "capable of" or "adapted to"; such language does not require steps to be performed nor limits the claim to a particular structure. In re Hutchison, 69 USPQ 138. See MPEP 2111.04.

Regarding **Claim 1** Bontemps et al. discloses a method for providing and configuring communication links, the method comprising:

determining any one usable media pair from all existing media pairs(*see figure 2, element 220a and 220b, contact pair*) (*see abstract, lines 1-3*) ;

selecting any one channel from all existing channels(*see figure 2, element 202, port1-N*) (*see column 3, lines 58-61*); and

assigning said selected any one channel to said any one media pair(*see column 3, lines 58-62, A control circuit is provided that toggles the selected circuit between the first and second states until a link detect signal indicates the reception of communication signals. The control circuit holds the select circuit in the particular state in which valid communication signals were detected*).

Claims 11 and 21 are the corresponding machine-readable storage and system claims for the above-mentioned claim and are thus rejected under same rationale.

Regarding **Claim 2**, Bontemps et al. discloses everything as claimed above (see claim 1). In addition, the method includes:

wherein said determining further comprises monitoring at least said any one usable media pair(*see column 3, lines 50-52, the physical layer device monitors its receive input for transmitted communication signals and provided a link detect signal indicative thereof*).

Claims 12 and 22 are the corresponding machine-readable storage and system for the above-mentioned claim and are thus rejected under same rationale.

Regarding **Claim 3**, Bontemps et al. discloses everything as claimed above (see claim 2). In addition, the method includes:

wherein said monitoring further comprises detecting an existence of a communication signal on said any one usable media pair(*see column 5, lines 31-36, physical layer device (second device), monitoring for communication signals in each of the first and second states of the select logic until valid communication signals are detected, and holding the select logic in one of the first and second*

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states in which a link detect signal indicates detection of valid communication signals).

Claims 13 and 23 are the corresponding machine-readable storage and system for the above-mentioned claim and are thus rejected under same rationale.

Regarding **Claim 4**, Bontemps et al. discloses everything as claimed above (see claim 1). In addition, the method includes:

further comprising determining which one of said all existing media pairs is capable of facilitating communication at a maximum communication speed (**see column 4, lines 6-14, a combination of protocols is also contemplated, the ports may include a first set of ports 10based-T and a second 100Base-TX).**

Claims 14 and 24 are the corresponding machine-readable storage and system for the above-mentioned claim and are thus rejected under same rationale.

Regarding **Claim 5**, Bontemps et al. discloses everything as claimed above (see claim 4). In addition, the method includes:

further comprising cross-connecting said selected any one channel to said one of said all existing media pairs capable of facilitating communication at a maximum communication speed(**see column 6, line 60- column 7, line 6, each PHY device of each ports would include a crossover function).**

Claims 15 and 25 are the corresponding machine-readable storage and system for the above-mentioned claim and are thus rejected under same rationale..

Regarding **Claim 6**, Bontemps et al. discloses everything as claimed above (see claim 1). In addition, the method includes:

further comprising determining which one of said all existing media pairs is capable of operating at a reduced communication speed(**see column 4, lines 6-14, a combination of protocols is also contemplated, the ports may include a first set of ports 10based-T and a second 100Base-TX).**

Claims 16 and 26 are the corresponding machine-readable storage and system for the above-mentioned claim and are thus rejected under same rationale.

Regarding **Claim 7**, Bontemps et al. discloses everything as claimed above (see claim 6). In addition, the method includes:

further comprising cross-connecting said selected any one channel to said one of said all existing media pairs capable of operating at said reduced communication speed(**see column 6, line 60- column 7, line 6, each PHY device of each ports would include a crossover function).**

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Claims 17 and 27 are the corresponding machine-readable storage and system for the above-mentioned claim and are thus rejected under same rationale.

Regarding **Claim 8**, Bontemps et al. discloses everything as claimed above (see claim 1). In addition, the method includes:

further comprising:

flipping at least one of a channel(*see figure 2, element 202, port1-N*) and a media pair(*see figure 2, element 220a and 220b, contact pair*) assignment of a previously defined general channel and media pair configuration which defines channel and media pair assignments for at least a portion of said all existing media pairs(*see column 4, lines 62-65*); and

defining said flipped at least one said channel and said media pair assignment as a default channel and media pair configuration(*see column 4, lines 62-65, the physical layer device to the appropriate contacts of the ports connector for performing a straight-through connection in one state (first combination) and a crossover connection in another state(second combination)*)).

Claims 18 and 28 are the corresponding machine-readable storage and system for the above-mentioned claim and are thus rejected under same rationale.

Regarding **Claim 9**, Bontemps et al. discloses everything as claimed above (see claim 1). In addition, the method includes:

further comprising identifying a status of at least one of said all existing media pairs and at least one of said all existing channels(*see column 3, lines 50-52, the physical layer device monitors its receive input for transmitted communication signals and provided a link detect signal indicative thereof*).

Claims 19 and 29 are the corresponding machine-readable storage and system for the above-mentioned claim and are thus rejected under same rationale.

Regarding **Claim 10**, Bontemps et al. discloses everything as claimed above (see claim 9). In addition, the method includes:

further comprising storing said identified status(*see column 3, lines 50-52, the physical layer device monitors its receive input for transmitted communication signals and provided a link detect signal indicative thereof*).

Claims 20 and 30 are the corresponding machine-readable storage and system for the above-mentioned claim and are thus rejected under same rationale.

Citation of Pertinent Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dove et al. (US Patent Number 6,175,865) disclose a apparatus for automatically configuring network media connections;

Coffey (US patent Number 6,684,347) discloses a method and system for MDI crossover control;

Romano et al. (US Patent Number 6,661,805) see abstract.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mon Cheri S. Davenport whose telephone number is 571-270-1803. The examiner can normally be reached on Monday - Friday 8:00 a.m. - 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eliseo Ramos-Feliciano can be reached on 571-272-7925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MD/md
February 13, 2007



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